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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,463	02/17/2004	Phillip Clark	MCA-640 CIP/US	1395

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EXAMINER	
AKRAM, IMRAN	
ART UNIT	PAPER NUMBER
1795	
MAIL DATE	DELIVERY MODE
04/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,463	CLARK ET AL.	
	Examiner	Art Unit	
	IMRAN AKRAM	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *17-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 32-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/28/08 have been fully considered but they are not persuasive. Applicant has amended claims 1, 2, 5, and 14. Reference rejections still apply.

2. Regarding claim 1, Applicant argues on page 10 that Moring, Stanchfield, and Bloecker do not teach "said stacked unit positioned between said collar and said base." Moring, Stanchfield, and Bloecker all disclose the stacked unit to be positioned between the collar and the base. They all disclose parts of both the first and second devices to be enclosed within the collar and the base. The collar **38** of Moring can be read to include the clamp **34** upon the collar. The cover **30** of Bloecker behaves as both a cover and a collar.

3. Regarding the Obvious-Type Double Patenting Rejection of the previous office action, it should be noted that no arguments have been presented nor has a terminal disclaimer been file to traverse this rejection. Therefore, it still stands.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

> granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 11-13, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Moring (US 6,159,368).

8. Regarding claims 1, 2, 6, 7, and 11-13, Moring teaches a multiwell microfiltration apparatus for filtering samples. The device is best shown in Figures 3 and 4 and described in columns 12-14. The device of Moring has a first sample processing device having an outer perimeter edge (filter plate #10), a second sample processing device (receiving plate #24) stacked below the first processing device, a collar (38) with clamp (34), a base (51) having a vacuum port (51), a first seal (gasket #44) between the collar and base, and a second seal (gasket #42) between the first sample processing device and the collar. The stacked unit is positioned between said collar/clamp and said base.

9. Regarding claims 3-5, 32, and 33, collection plates (column 12), flow directors (column 17, lines 48-53), and support plates (column 34) are disclosed by Moring.

10. Regarding claim 8, the Examiner considers a deformable gasket (col. 14, lines 28-30) as allowing for variability in the height of the processing devices since it may be deformed.

11. Regarding claim 34, Moring discloses the top surface of the first sample processing device to lie below the top surface of the collar/clamp combination (see figure 3).

12. Claims 1-3, 5-8, 11-16, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanchfield (US 6,054,100).

13. Regarding claims 1-3, 5-7, 11-13, 32, and 33, Stanchfield teaches a multiwell microfiltration apparatus for filtering samples. The device is best shown in Figures 12 and 13 and described in columns 12-14. The device of Stanchfield has a first sample processing device having an outer perimeter edge (well block #12), a second sample processing device (collection plate #123) stacked below the first processing device, a collar (104) positioned on the outer perimeter edge of said first sample processing device, a base (102) having a vacuum port (120), a first seal (gasket #106) between the collar and base, and a second seal (gasket #108) between the first sample processing device and the collar. The stacked unit is positioned between said collar and said base (see figure 8).

14. Regarding claim 8, the Examiner considers the use of a gasket between elements of the device as an element that allows for variability in the height of the processing devices since it may be deformed.

15. Regarding claims 14-16, Stanchfield discloses a manifold assembly comprising: a collar (104); a base (102) in sealing engagement with said collar, the base comprising an outer peripheral flange (390) and a side wall which together form a peripheral groove (116), and a portion of a gasket (108) contacts a slot formed in the collar, and the collar comprises a skirt (132) formed along a bottom periphery of a lateral wall such that the skirt positions over a peripheral portion of the base (see figure 12); a multiwell filtration plate (12) positioned in sealing engagement with said collar; and a removable support (106) positioned below said sample processing device.

16. Claims 1-9, 11-13, and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloecker (US 6,592,826).

17. Regarding claims 1, 2, 6, 7, and 11-13, Bloecker teaches a multiwell microfiltration apparatus for filtering samples. The device is best shown in Figures 2, 4, 7 and 8 and described in columns 7-8. The device of Bloecker has a first sample processing device having an outer perimeter edge (upper support #F1), a second sample processing device (lower support #F2) stacked below the first processing device, a collar (cover #30) positioned on the outer perimeter edge of said first sample processing device (see figure 8), a base (#1) having vacuum ports (7,8), a first seal (gasket #16) between the collar and base, and a second seal (gasket #44) between the first sample processing device and the collar. The stacked unit positioned between said collar and said base (see figure 8).

18. Regarding claims 3-5, 32, and 33, filter plates (column 2, lines 59-67) and collection plates and spacers (column 3, lines 21-37) are disclosed by Bloecker.

19. Regarding claim 8, the Examiner considers the use of a gasket between elements of the device as an element that allows for variability in the height of the processing devices since it may be deformed.

20. Regarding claim 9, Bloecker discloses a collar wherein said first seal is created with a gasket positioned with the base, said sealing being along the substantially vertical side walls of said collar (column 6, lines 23-45 and figure 3).

21. Regarding claim 34, Bloecker discloses the top surface of the first sample processing device to lie below the top surface of the collar (see figure 8).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

26. Claims 10 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moring.

25. Regarding claim 10, Moring discloses the claimed invention except that first and second seals are a unitary seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first seal and second seal into a unitary seal, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works,* 150 U.S. 164 (1993).

26. Regarding claim 35, Moring discloses a manifold assembly comprising: a collar (38) with clamp (34); a base (51); a first sample processing device (10) having an outer perimeter edge; a second processing device (24) stacked below said first sample processing device to form an integral stacked unit preventing relative movement between said first and second devices, said stacked unit positioned between said collar and said base, and said collar is positioned on the outer perimeter edge of said first sample processing device (see figure 3); a first seal (44) between said collar and said base; and a second seal (42) between said first sample processing device and said collar. Moring discloses the claimed invention except that first and second seals are a unitary seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first seal and second seal into a unitary seal, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works,* 150 U.S. 164 (1993).

27. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloecker.

27. Regarding claim 35, Bloecker discloses a manifold assembly comprising: a collar (30); a base (1); a first sample processing device (F1) having an outer perimeter edge; a second processing device (F2) stacked below said first sample processing device to form an integral stacked unit preventing relative movement between said first and second devices, said stacked unit positioned between said collar and said base, and said collar is positioned on the outer perimeter edge of said first sample processing device (see figure 8); a first seal (16) between said collar and said base; and a second seal (44) between said first sample processing device and said collar. Bloecker discloses the claimed invention except that first and second seals are a unitary seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first seal and second seal into a unitary seal, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works,* 150 U.S. 164 (1993).

28. Regarding claim 36, Bloecker discloses the top surface of the first sample processing device to lie below the top surface of the collar (see figure 8).

29. Regarding claim 37, Bloecker discloses a manifold assembly comprising: a base (1); a collar (30) comprising a skirt (36) formed along a bottom periphery of a lateral wall such that the skirt positions over a peripheral portion of the base (see figure 7); a first sample processing device (F1) comprising a multiwell filtration plate; a second

processing device (F2) stacked below said first sample processing device to form an integral stacked unit preventing relative movement between said first and second devices, said stacked unit positioned between said collar and said base (figure 7); a first seal (16) between said collar and said base; and a second seal (44) between said first sample processing device and said collar; wherein the first sample processing device is seated recessed (5) within the collar such that the top surface of the first sample processing device lies below the top surface of the collar (see figure 7). Bloecker discloses the claimed invention except that first and second seals are a unitary seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first seal and second seal into a unitary seal, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works,* 150 U.S. 164 (1993).

Double Patenting

30. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

31. Claims 1-16, 32, and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-15 of copending Application No. 10/602,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/602,426's claims anticipate applicant's claims: Claims 1 and 5 (of reference) anticipate claim 1 (of application); claim 2 anticipates claim 2; claim 3 anticipates claim 5, claim 4 anticipates claims 4, 32, and 33; claims 6-11 anticipate claims 6-11, respectively; and claims 12-15 anticipate claims 13-16, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMRAN AKRAM whose telephone number is (571)270-3241. The examiner can normally be reached on 10-7 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA

/Alexa D. Neckel/
Supervisory Patent Examiner, Art Unit 1795